

REQUEST TO WITHDRAWAL FINALITY OF OFFICE ACTION
EXPEDITED PROCEDURE
GROUP 1773
PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q78604

Yuichiro MURAYAMA, et al.

Appln. No.: 10/725,522

Group Art Unit: 1773

Confirmation No.: 4994

Examiner: 1773

Filed: December 3, 2003

For: MAGNETIC RECORDING MEDIUM

REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION
AND TO ISSUE NEW OFFICE ACTION

MAIL STOP AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants respectfully request withdrawal of the finality of the Office Action dated January 19, 2007 and issuance of a new Office Action with a new time period for reply.

Applicants respectfully submit that the Examiner improperly made the first Action after filing of an RCE final in view of the following facts.

A Final Office Action was issued on April 29, 2005.

In response, Applicants filed an Amendment under 37 C.F.R. § 1.116, a Petition for Extension of Time and the required fee and an Excess Claim Fee Payment Letter and the required fee on October 6, 2005.

In the Amendment under 37 C.F.R. § 1.116, independent claim 1 was amended to recite a preferred embodiment of the invention, “wherein the molecular weight of the radiation-curing compound is 1,000 or less”. Additionally new claims 21 and 22 were added which are directed to a preferred embodiment wherein the molecular weight of the radiation-curing compound of claim 8 is from 200-600 and to preferred difunctional compounds of claim 8, respectively.

An Advisory Action was mailed on October 24, 2005, which indicated that the proposed amendments filed after final rejection would not be entered because they raise new issues that would require further consideration and/or search. Specifically, the Examiner stated, “the claims are directed to an embodiment not previously claimed or considered”.

Subsequently, on October 31, 2005, Applicants filed a Request for Continued Examination (RCE) and the required fee under 37 C.F.R. § 1.17(e).

On January 19, 2007, a Final Office Action was mailed.

Applicants respectfully submit that it is improper to make the first Action after an RCE final under these circumstances. Specifically, MPEP § 706.07(h)(VIII) states:

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 C.F.R. § 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met (emphasis added).

MPEP § 706.06(b) states:

[I]t would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because

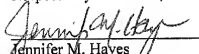
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Thus, since the Examiner did not enter the amendments to the claims presented in the Amendment under 37 C.F.R. § 1.116 filed on October 6, 2005 and indicated that the amendments raised new issues that required further consideration and/or search, it is improper to make the first Action, after filing of an RCE and the required fee, final.

Accordingly, Applicants respectfully request withdrawal of the finality of the Office Action dated January 19, 2007 and issuance of a new Office Action with a new time period for reply.

Respectfully submitted,


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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: February 1, 2007